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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,707	02/07/2001	Peter R. Badovinatz	POU996048US3	5326
23405	7590	09/07/2004	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			LAO, SUE X	
			ART UNIT	PAPER NUMBER
			2126	10

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,707

Applicant(s)

BADOVINATZ ET AL.

Examiner

S. Lao

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/5/04, 3/25/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 are presented for examination. This action is in response to the amendments filed 2/5/2004 and 3/25/2004. Applicant has added claims 7-31.

2. Applicant provided a list of co-pending applications on pages 1-2. These are not checked. Applicant is invited to inform the examiner if any of the co-pending applications are particularly relevant to / conflicting with the current application. Applicant is required to maintain a clear line of demarcation between applications. See MPEP § 822.

3. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7, 14 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,026,426. Although the conflicting claims are not identical, they are not patentably

Art Unit: 2126

distinct from each other. In particular, claim 1 is met by claim 1 of U.S. Patent No. 6,026,426; claims 2 and 3 are respectively met by claims 4 and 5 of U.S. Patent No. 6,026,426; claim 4 is met by claims 1-3 of U.S. Patent No. 6,026,426; claim 5 is met by claim 7 of U.S. Patent No. 6,026,426. As to claim 6, note the discussion of claim 1 and further that joining and leaving are typical membership management which is met by claim 4 of U.S. Patent No. 6,026,426. As to claim 7, it is met by claims 4 and 5 of U.S. Patent No. 6,026,426. As to claim 15, it is met by claim 14 of U.S. Patent No. 6,026,426.

5. Claims 8-31 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,052,712. Although the conflicting claims are not identical, they are not patentably distinct from each other. In particular, claim 16 is met by claims 3, 6, 9, 10, 11, 20(f) of U.S. Patent No. 6,052,712; claim 17 is met by claim 3 of U.S. Patent No. 6,052,712. As to claims 18-20, these are met by claims 15-16 of U.S. Patent No. 6,052,712. As to claims 21-23, these are met by claims 17, 18 and 12 of U.S. Patent No. 6,052,712. As to claims 24-31, note claims 16-23, respectively. As to claim 8, note discussion of claim 16 and claim 11 of U.S. Patent No. 6,052,712. As to claims 9-15, note discussions of claims 17-23, respectively.

6. Claims 8-31 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 3-27 of U.S. Patent No. 5,768,538. Although the conflicting claims are not identical, they are not patentably distinct from each other. In particular, claim 16 is met by claims 3, 6, 9, 10, 11, 20(f) of U.S. Patent No. 5,768,538; claim 17 is met by claim 3 of U.S. Patent No. 5,768,538. As to claims 18-20, these are met by claims 15-16 of U.S. Patent No. 5,768,538. As to claims 21-23, these are met by claims 17, 18 and 12 of U.S. Patent No. 5,768,538. As to claims 24-31, note claims 16-23, respectively. As to claim 8, note discussion of claim 16 and claim 11 of U.S. Patent No. 5,768,538. As to claims 9-15, note discussions of claims 17-23, respectively.


Art Unit: 2126

7. Applicant's arguments filed 2/5/2004 have been considered but are moot in view of the new ground(s) of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (703) 305-9657. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (703) 305 9678. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

September 3, 2004



SUE LAO
PRIMARY EXAMINER